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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,293	05/25/2001	Michael E. Aufricht	1933.0010008	3536

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EXAMINER

DURAN, ARTHUR D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/864,293	Applicant(s) AUFRICHT ET AL.	
	Examiner Arthur Duran	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 16-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 13-15 and 28-45 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/19/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-12 and 16-27 have been examined.

Response to Amendment

2. The Amendment filed on 4/22/05 is sufficient to overcome the prior 35 USC 101 rejection.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12 and 16-27, drawn to pre-populating a field in an advertisement displayed to a user with user location information, classified in class 705, subclass 14.
 - II. Claims 13-15 and 28-30, drawn to targeting a user based on location and time, classified in class 705, subclass 14.
 - III. Claims 31-35 and 36-40, drawn to downloading a multitude of advertisements to a client device and rotating the display of advertisements to the user, classified in class 705, subclass 14.
 - IV. Claim 81, drawn to utilizing triggers and estimating what may be of interest to a user, classified in class 705, subclass 14.

Inventions I, II, III, and IV are based on different sets of Independent claims. Group I involves pre-populating a field in an advertisement displayed to a user with user location information. Group II involves targeting a user based on location and time. Group III involves downloading a multitude of advertisements to a client device and rotating the display of

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advertisements to the user. Group IV involves utilizing triggers and estimating what may be of interest to a user.

Because these inventions are distinct for the reasons given above and the search required for Group I is different than the search required for Groups II, III, and IV, restriction for examination purposes as indicated is proper.

During a telephone conversation with Jeffrey S. Weaver (Reg. No. 45,608) on 7/28/2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-12 and 16-27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-15 and 28-45 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Priority

4. Applicant's statement that the present application 09/864,293 is a Continuation-In-Part (CIP) of Applications 09/559,964 and 09/393,390 is noted. However, the Examiner notes that this Application, 09/864,293, does not benefit from an earlier filing date. There is inadequate support under 35 USC 112 in the CIP applications. The CIP applications do not disclose any pre-populating of an advertisement with address location information related to the user. Hence, the present application, 09/864,293, has a priority date to the present application's filing date which is 5/25/2001.

Claim Rejections - 35 USC § 112

5. Claim 12, 27 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 and 27 disclose a 'provider' and a 'server'. However, the use of these terms in the claim relevant to their independent claim 1 and 26, respectively, is unclear. For example, it is unclear if the server is hardware or a business or a user. Also, it is unclear who the provider is and what they are providing.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 4, 6, 7, 9-11, 13-17, 19, 21, 22, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw (6,516,341).

Claim 1, 2, 4, 6, 16, 17, 19, 21: Shaw discloses computer implemented method for placing advertisements with interactive content on devices, comprising the steps of:

- (1) displaying an advertisement with interactive content on a device (Fig. 10),
- (2) pre-populating at least one field of the advertisement with address location information relating to the user of the device;

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(3) conditionally forwarding the at least one pre-populated field to an entity associated with the advertisement to provide information regarding the user to the entity:

“(39) By clicking on the banner advertisement 800, the user may be provided with an e-mail message template to create an e-mail message (as described in connection with FIG. 12 below), having the addressee already filled in with the e-mail address of a company associated with the subject matter of the current banner advertisement 800. In this manner, the user may, for example, provide comments to the company regarding the subject matter of the banner advertisement 800 or request further information. Alternatively, clicking on the banner advertisement 800 may cause an e-mail message to be automatically completed (including the message) and either transmitted immediately or stored in the user's "outbox" folder (described later). The message may merely identify the user to the addressee of the e-mail message as someone interested in the subject matter of the banner advertisement 800 (col 13, line 55-col 14, line 5);

(23) The first time that the client computer software is executed on the client computer 101 (and whenever a user wishes to establish a new account with the server system 104), the client program performs various function intended to establish a new account for the user. In the representative embodiment, the first step is to collect new account information (step 301). At the request of the client program, the user inputs name, address, telephone number and other identification data. This information is stored on storage device 206 (col 11, lines 48-60);

(32) It will be appreciated that in alternative embodiments, the member profile may be transmitted to the server system 104 at step 304 along with the selected e-mail address and password” (col 12, lines 62-67).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that user address information can be sent along with the pre-filled email. One would have been motivated to do this in order to provide relevant user information for better profiling and tracking of the user.

Shaw further discloses caching content (col 2, lines 25-35).

Therefore, it would be obvious to one skilled in the art that Shaw's content which is forwarded can be done so at a later time. One would be motivated to do this in order to allow greater off-line utilization.

Claim 7, 22: Shaw discloses the method of claim 1. Shaw further discloses that a base fee is paid by an advertiser for having the advertiser's advertisement displayed on the device (col 6, lines 35-40).

Claim 9, 24: Shaw discloses the method of claim 1. Shaw further discloses that the advertisement displayed on the device is targeted for specific users by the advertiser, wherein advertiser targeting of specific users comprises the steps of:

- (a) receiving an advertisement with user preferences,
- (b) identifying users that match the user preferences; and
- (c) loading the advertisement on devices of users identified in step (b) (col 2, lines 40-50; col 5, lines 5-16).

Claim 10, 25: Shaw discloses the method of claim 9. Shaw further discloses that the advertisement is loaded on devices of users in real time (col 2, lines 13-24).

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Claim 11, 26: Shaw discloses the method of claim 9. Shaw further discloses that the advertisement is loaded on devices of users during a subsequent sync operation (col 2, lines 25-32).

7. Claims 3, 5, 18, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw (6,516,341) in view of Goldhaber (6,794,210).

Claim 3, 5, 18, 20: Shaw discloses the method of claim 1.

Shaw discloses charging a fee to an advertiser (col 6, lines 35-40).

Goldhaber does not explicitly disclose that a fee is paid by the advertiser for each pre-populated address field forwarded to the advertiser.

Goldhaber discloses charging per item(s) of content about a user provided to the advertiser (col 6, line 60-col 7, line 10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goldhaber's charging per item(s) of content about a user provided to the advertiser to Shaw's charging fees to an advertiser. One would have been motivated to do this in order to better charge for services or information relevant to an advertiser.

8. Claims 8, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw (6,516,341) in view of Bandera (6,332,127).

Claim 8, 23: Shaw discloses the method of claim 1.

Shaw further discloses :

(a) accessing a user profile associated with the user of the device;

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(c) selecting one or more advertisements based on one or more of the user profile; and
(d) transmitting the one or more advertisements selected in step (c) to the device (col 2, lines 40-50; col 5, lines 5-16).

Shaw discloses tracking at what time the user is presented certain content:

“(16) Accordingly, there exists a need for a targeted advertisement system that also can provide information as to the characteristics of those who were exposed to each advertisement, for how long the user was exposed, and at what times”(col 2, lines 54-59).

Shaw does not explicitly disclose time and location based targeting.

However, Bandera discloses targeting a user and targeting a user for advertising based on location and time (col 8, lines 50-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Bandera's targeting based on location and time to Shaw's targeting and time tracking. One would have been motivated to do this in order to better target a user with relevant advertising.

9. Claims 12, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw (6,516,341) in view of Angles (5,933,811).

Claim 12, 27: Shaw discloses the method of claim 1.

Shaw does not explicitly disclose enabling a user of the device to conduct business with a provider, wherein revenue from said business is shared between the provider and a server that enables access to the provider.

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However, Angles discloses sharing revenues between involved parties and that an object of advertising is inciting purchasing (col 4, lines 25-47; col 2, lines 30-35).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Angles revenue sharing to reduce costs to Shaw's charging for advertising. One would have been motivated to do this in order to better distribute and compensate for costs.

Response to Arguments

10. Applicant's arguments with respect to claims 1-12 and 16-27 have been considered but are moot in view of the new ground(s) of rejection.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Also, Examiner notes that features in the preamble, such as in claim 8, are not given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See

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In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Also, Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a) Bezos (6,028,141) discloses sharing business revenues;
- b) Gerace (5,848,396) discloses profiling, targeting a user, purchasing, and cost sharing;
- c) Dedrick (5,724,521) discloses control over what information about a user is shared.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Arthur Duran', is positioned above the printed name.

Arthur Duran
Patent Examiner
7/27/2005